

(2)
No. 84-173

In the Supreme Court

OF THE

United States

OCTOBER TERM, 1984.

COMPUTERVISION CORPORATION,
Petitioner,

v.

THE PERKIN-ELMER CORPORATION,
Respondent.

On Petition for a Writ of Certiorari to the
United States Court of Appeals
for the Federal Circuit.

OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI

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LISTING OF RELATED CORPORATIONS

There are no parent companies, subsidiary companies (other than wholly owned subsidiaries) or affiliate companies of the Respondent THE PERKIN-ELMER CORPORATION.



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OPINIONS BELOW

The opinion of the Court of Appeals for the Federal Circuit rendered in this case on April 6, 1984, has been officially reported at 732 F.2d 888.

STATEMENT OF THE CASE

The statement of the case provided by the Petitioner requires some amplification to present a more balanced picture of the case to this Court.

The two patents in suit, Offner No. 3,748,015, and Scott No. 3,821,763, while related in that the principles of both are employed in the Perkin-Elmer and Computervision optical systems, are nonetheless directed to different inven-

tions. The Offner patent is directed to a specific optical system employing, among other things, a convex mirror and a concave mirror spaced relative to each other such that a corrected image, i.e., an essentially perfect one, is obtained. That perfect imagery is obtained by moving the convex mirror a small but extremely significant distance from the location it would assume if the two mirrors were concentric and the radius of curvature of the convex mirror was one-half that of the concave mirror. The necessary spacing of the mirrors can be obtained either by increasing the radius of the convex mirror while keeping the mirrors concentric, or by keeping the radius of the convex mirror one-half that of the concave mirror and slightly separating the centers of curvature.

The Scott patent is directed to the concept of preferentially correcting an optical system so that a small part of it produces perfect imagery, restricting what the optical system sees only to the portion that creates perfect imagery, and scanning the optical system across the scene to be viewed so that a perfect image of the entire scene can be recorded by photosensitive material.

The evidence established that those skilled in the art found the Offner invention "astounding", and the Scott invention "a radical departure from traditional optical practice."

Perkin-Elmer's projection printer, having as its critical element an optical system employing the inventions of both the Offner and Scott patents, was the first commercially successful projection printer for use in manufacturing semiconductor integrated circuits, and was an outstanding commercial success. It had numerous advantages over previous printers, became the industry standard, revolutionized the industry and satisfied a long felt need.

After a number of unsuccessful efforts to design its own optical system, Computervision decided to copy the Perkin-Elmer system; after several modifications, Computervision settled on one that was virtually the same as Perkin-Elmer's. The only difference was that in the Computervision system, the radii of the two mirrors were kept the same and the centers moved, while in the Perkin-Elmer system, the centers were kept concentric and the radius of the convex mirror slightly increased. In both systems, the convex mirror ended up at the same place relative to the concave mirror. In both systems, perfect imagery was obtained as a result of the positioning of the convex mirror. All of the witnesses who testified on the point, whether put forth by Perkin-Elmer or Computervision, agreed that the arrangement of the mirrors in the two systems was equivalent, i.e., they accomplished substantially the same result and worked in substantially the same way. The Court of Appeals for the Ninth Circuit found that the differences between the two systems are "miniscule" (680 F.2d 669, 671).¹

At the trial, in its post-trial motions, and on both appeals (and in its Petition), Computervision asserted that Reed patent No. 3,190,171 showed a system that made invalid the Offner patent.² At the trial level, the jury rejected Computervision's argument and returned a verdict that the Offner claims were valid. In the first appeal, Computervision argued to the Ninth Circuit that if the claims of the Offner patent were construed to cover the Computervision system, the claims would also cover Reed and be invalid. The Ninth Circuit disagreed.

¹The statement on page 3 of the Petition that there are "marked differences" between the two devices is unsupported by the record and contrary to the law of the case.

²In its appeal to the Federal Circuit Computervision made virtually no argument relating to the Scott patent and makes none here.

When the case was returned to the trial court, extensive briefs were filed and an oral argument was had on the question of validity, Computervision once again urging the Reed patent as invalidating prior art. After reviewing the briefs and hearing the argument, the District Court stated that the findings of the jury supported a conclusion of non-obviousness, that there was considerable evidence supporting those findings, and that non-obviousness was clear as a matter of law. The court then entered its judgment that both patents were valid and infringed. Subsequently, the District Court denied Computervision's motions for judgment notwithstanding the verdict and for a new trial, which motions were based primarily on its arguments concerning the Reed patent.³

On its appeal to the Federal Circuit, Computervision once again advanced its contentions with regard to the Reed patent. Once again they were rejected, for they simply have no merit. As the Federal Circuit said:

"The Reed patent (3,190,171), considered by the PTO, discloses a viewing system simulating the appearance of an aircraft carrier as the pilot approaches for a landing. The system employs concentric convex and concave mirrors with a radii ratio of 2:1. The image system of the carrier is not of unity magnification and is a viewing, not an image forming, system; the carrier image is a virtual, relatively poor image, whereas claim 1 [of Offner] requires formation of a real, stigmatic image; it involves a 2:1 mirror system, whereas claim 1 involves a non 2:1 system. Though Reed said he modified his system to achieve a non-concentric 2:1

³It is these actions by the District Court that illustrate its real belief and refute Computervision's argument (Petition, p. 5) that the District Court agreed with its contentions.

system, the modified system does not correspond to the concentric non 2:1 system of the '015 patent.

"Computervision urges that the Reed disclosure be viewed backwards, i.e., as a system for forming an image of the pilot's eye. There is no evidence that those of ordinary skill in the art would so view it, and such distortion of a reference in light of a patentee's disclosure is pure hindsight." (732 F.2d 896, 897)

REASONS FOR DENYING THE WRIT

This is a routine patent case in which the losing party is, not surprisingly, unhappy with the outcome. Computervision has previously presented its arguments to the jury, the District Court, the Court of Appeals for the Ninth Circuit, and the Court of Appeals for the Federal Circuit. In each instance it has been rebuffed. It now seeks to have this Court involve itself in this private dispute and give it another chance to try to accomplish what it so singularly has been unable to accomplish thus far. The record establishes that no matter how many chances Computervision might be given, it could not succeed, because the patents in suit are clearly valid. But, more importantly here, Computervision has set forth in its Petition no sufficient reason for this Court to grant the writ requested, and it should be given no further opportunities to replot old ground.

In an attempt to make this case seem more than it is — a controversy between two private parties — Computervision has asserted that it could have far reaching ramifications because, it says, the comments of the Court of Appeals for the Federal Circuit with regard to the procedure followed run counter to the "directive" of this court in *Altwater v. Freeman*, 319 U.S. 359 (1943) and *Electrical Fittings Corp. v. Thomas & Betts Co.*, 307 U.S. 241 (1939). Because this assertion is central to the first two reasons for

granting the writ urged by Computervision, we will deal with it first.

A. The Comments of the Court of Appeals Were Not Contrary to Any Instructions or Directives Issued by This Court

Computervision expresses concern over the comments by the Court of Appeals with respect to the procedural aspects of this case, specifically the initial entry of a judgment dealing with only a portion of the jury's verdict — non-infringement. But the Court of Appeals only pointed out the obvious — the piecemeal entry of judgment and consequent multiplicity of appeals unnecessarily consumes judicial time and effort. The Court of Appeals set forth no binding rule of law or procedure that must be reviewed by this Court.

Computervision's arguments that the Court of Appeals' comments were contrary to some ironclad rule of procedure laid down by this Court in *Altwater* and *Electrical Fittings* are simply wrong. Neither of those cases set forth any instruction or directive that are to be followed in every case, and both were quite different on their facts than the present case. The *Altwater* case, the closer on the facts, and apparently the case principally relied on by Computervision, produced a result directly contrary to that which Computervision urges it for.

In *Altwater*, the Court distinguished *Electrical Fittings*, pointing out that in the latter there was only a bill of complaint and an answer, while in *Altwater* there was also a counterclaim for a declaratory judgment that the patents in suit were invalid. In those circumstances, the Court held, there was still a dispute between the parties that should be litigated. The Court accordingly reversed the Court of Appeals decision that the validity issues were moot, and

remanded the case for consideration of those issues, even though the patents had been found to be not infringed. In the present case, Computervision also counterclaimed for a declaratory judgment that the patents were invalid.

That this Court has issued no directive that validity should not be considered once non-infringement has been found is clear from *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327 (1945), a case decided only two years after *Altwater*. In *Sinclair & Carroll*, the Court criticized the tendency of lower courts to dispose of cases on the grounds of non-infringement without reaching the validity issue. The Court said that the District Court had followed the better practice of deciding validity as well as infringement. At most, that is all that the Court of Appeals was suggesting in the present case.

That the Court of Appeals for the Federal Circuit recognizes that in the proper situation only non-infringement need be determined is apparent from its recent, and as yet unreported, decision in *Nestier Corporation v. Menasha Corporation*, Appeal No. 83-1313, decided August 1, 1984. In the circumstances present there, the court recognized that since the patent had been judged to be not infringed, an adjudication that the patent was valid would be to decide an unnecessary question as between the parties (Slip opinion, p. 10). Computervision's expressed fear that the present case would somehow set a precedent that would prevent courts from following *Electrical Fittings* is thus shown to be without foundation.

B. Computervision Was Not Denied Its Right to a Jury Trial

Computervision's assertion that it was denied a jury trial on the factual inquiries of *Graham v. John Deere Co.*, 383 U.S. 1 (1966) is based on speculation and a misconception

of the doctrine of equivalents and its relationship to the validity of a patent.

Computervision had a jury trial on the *Graham* issues. The evidence on these issues was presented in great detail, the jury was properly instructed by the District Court, and the jury returned a verdict against Computervision. Computervision argues that the jury, in finding validity, had a particular interpretation of the claims in mind. But as the Court of Appeals for the Federal Circuit rightly pointed out, this argument depends on facts merely presumed and not established; it is not at all necessary that the Ninth Circuit adopted a different interpretation of the claims in reaching its conclusion that the Computervision optical system was essentially the same as the patented optical system (732 F.2d at page 899).⁴

Indeed, it seems clear that the opposite must be true. A case cited by Computervision (Petition, p. 16) *Carman Industries, Inc. v. Wahl*, 724 F.2d 932 (Fed. Cir. 1983), demonstrates why this must be so. As pointed out by the Court in *Carman*, the doctrine of equivalents cannot be applied in aid of a finding of infringement if doing so results in the invalidity of the claims in view of the prior art. In other words, the Ninth Circuit could not properly construe the claims so as to nullify the finding of validity made by the jury, nor its own presumption of validity. Computervision argued to the Ninth Circuit that any interpretation of the claims that would have them encompass the Computervision apparatus would invalidate them. The Ninth Circuit disagreed and found infringement even taking the prior art, including Reed, into account.

⁴Computervision seems to argue (Petition, p. 12) that an improvement to a patented system should be free from a finding of infringement. The law is to the contrary. *Temco Co. v. Apco Co.*, 275 U.S. 319 (1928).

What Computervision is really attacking here is not the decision of the Court of Appeals for the Federal Circuit, but the decision of the Court of Appeals for the Ninth Circuit. But no writ was sought or granted in connection with the latter decision, and it is far too late to question it now.

The jury properly returned a verdict of patent validity. It was supported by substantial evidence. The District Court independently reviewed the evidence in light of *Graham v. John Deere Co.*, found that it supported the jury's verdict, and entered an appropriate judgment. The Court of Appeals for the Federal Circuit properly affirmed that judgment. There is no need for, nor right to, another jury trial on precisely the same issues.

C. There Was No Inconsistency Between the Opinions of the Federal and Ninth Circuit Courts of Appeal

Computervision's argument in support of its third reason for review is based on a distressingly inaccurate statement of the record, a mischaracterization of the opinion of the Court of Appeals, and a logical grotesquerie. It presents as fact the proposition that there was a Reed system that was non-concentric and 2:1 in the same way that the Computervision system was non-concentric and 2:1. There was no such evidence. It asserts that the Court of Appeals for the Federal Circuit emphasized, in distinguishing the Offner patent from the Reed patent, that the Reed patent employed concentric mirrors, which mirrors had a ratio of the radii of 2:1 (Petition, pp. 14, 15). While the Court did note those differences, what it emphasized was that the Reed patent was directed to a system entirely different in concept and construction than Offner, as pointed out on pages 4 and 5 of this brief.

As found by the three courts that have reviewed the evidence, there simply is no relationship between Reed and

Offner, nor between Reed and the Computervision optical system. There is, however, a definite relationship between Offner and the Computervision system — they are for all intents and purposes the same.

The false premise in Computervision's "logic" is apparent. The Ninth Circuit looked at the similarities between the Computervision system and the patents in suit and found infringement. The Federal Circuit looked at the differences between the patents in suit and Reed and found validity. There is no inconsistency in these findings for the Computervision system is totally different from Reed.

CONCLUSION

For the reasons given above, the writ should be denied.

Respectfully submitted,

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